

REMARKS

Applicant first wishes to thank the Examiner for his withdrawal of the drawing objections and the 35 U.S.C. §101 rejection of claims 21-23 in light of the amendments filed December 14, 2006.

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

In the outstanding Official Action of March 12, 2007, the Examiner “noted” that the claims recite the term “for” in the preamble or the body of the claims, where in the Examiner’s opinion, such a term indicates intended use. Applicant is not taking a position on this note by the Examiner, as Applicant respectfully submits that this issue is not pertinent to the patentability of the claims of the present application. However, Applicant fully reserves the right to revisit this issue either in the present application or in later-filed related applications.

The Examiner rejected claims 1-20 under 35 U.S.C. §101 because, in the Examiner’s opinion, the claimed invention is directed to non-statutory subject matter. Applicant traverses the rejection for the reasons set forth below.

The Examiner asserted that the language of claims 1, 8, and 17, for example, lack concreteness because, according to the Examiner, it is unknown whether the feature is provided to a consumer application and whether the feature is utilized. In addition, the Examiner asserted that it would be reasonable to interpret the claimed device as software per se and that Applicant’s specification provides no explicit and deliberate definition of the components (e.g., “consumer application,” “provider application,” and application interworking framework”). Applicant submits that the Examiner has mischaracterized the claims. In particular, Applicant submits that the method of claim 1, for example, merely provides a choice of providing a feature if a provider is identified. By this rejection, the Examiner is improperly requiring the Applicant to limit the method of claim 1 to a mode of operation where, presumably, a provider is always identified. However, the method does not have to be limited to such scenarios. Moreover, the language of claim 1 is explicit in

producing a useful, tangible, concrete result when it provides a feature if a provider is identified. Furthermore, claim 1 recites the limitation of “utilizing the feature at the consumer application.” Again, such language, contrary to the Examiner’s assertion, clearly and explicitly indicates that a concrete, tangible, and useful result is produced.

Furthermore, Applicant submits that software per se is not automatically deemed to be non-statutory subject matter. The court in *State Street Bank & Trust v. Signature Financial Group, Inc.* 149 F.3d 1368, 47 USPQ2d 1569 (Fed. Cir. 1998) held that

"(...) the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces 'a useful, concrete and tangible result' -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades." (*id.* at 1373)

Therefore, the transformation of data representative of some discrete entity into some useful, concrete, and tangible result amounts to patentable subject matter. In claims 1, 8, and 17 of the present application, a desired feature can be identified and matched with a provider application, where the desired feature can be used at a consumer application or at the least an interface for the consumer application is provided in conjunction with the ability to match a feature interest with a feature available from the provider application. Moreover, feature interests and/or provider capability can be published, where such information or data was not available until such publishing occurs.

Rather, as the Examiner himself has alluded, software is patentable if it produces a concrete, tangible, useful result. Applicant submits that claims 8 and 17, for example, do produce such a result. A consumer application, as would be understood by those of ordinary skill in the art, already implies some useful, tangible, concrete result, hence the term “application.” Furthermore, the Examiner is directed to pages 11-12 of the present application, for example, where Table 1 and the surrounding description clearly indicate exemplary applications that are contemplated by the present application, e.g., editing an image in “Image Viewer,” and offering command options for found items in text in a browser

messaging application, where a provider application is, for example, a phonebook application on a mobile device.

Therefore, Applicant respectfully submits that the Examiner has no bases for such a rejection and respectfully requests that the above rejections be withdrawn.

The Examiner rejected claims 1 and 11 under 35 U.S.C. § 112, second paragraph, as being indefinite, because in the Examiner's opinion, claim 1 is unclear as to whether the utilizing process is performed if the provider is not identified. In addition, the Examiner asserted that claim 11 is unclear as it raises a question of whether or not a new consumer application is part of an original group. Applicant respectfully traverses the rejection for the reasons set forth below.

As to claim 1, Applicant submits that providing the feature is dependent upon whether or not the provider can be identified. Therefore, if the feature is being utilized, it would have already have been provided. As to claim 11, Applicant submits that the recited claim language states that "the new consumer application integrates into the device as if part of an original group..." (emphasis added). The phrase "as if" indicates, for example, that even if the new consumer application were not part of an original group of software applications for the device, it would still be integrated as if it were. Paragraph [0035] of the present application further explains that "[t]he addition of the new feature 36 is done in a seamless manner... it seems to the user that the new feature is just another feature of Image viewer application." Therefore, Applicant submits that claim 11 already addresses a scenario, where, for example, the new consumer application is not part of the original group.

Claims 1-3, and 5-23 were rejection by the Examiner under 35 U.S.C. §103(a) as being unpatentable over International Application Publication WO 02/44892 (Mehta et al.) in view of U.S. Patent Publication No. 2004/0230963 (Rothman et al.) Claim 4 was rejected under 35 U.S.C. §103(a) Mehta et al., Rothman et al., and further in view of U.S. Patent No. 6,335,972 (Chandersekaran et al.) Applicant respectfully traverses the rejections for the reasons set forth below.

The Examiner asserted that Mehta et al. teaches requesting a feature matching a consumer interest of a consumer application, using the consumer interest and a feature capability to identify a provider, providing the feature, if the provider is identified, to the consumer application, and utilizing the feature at the consumer application. Applicant disagrees. In particular, Applicant submits that Mehta et al. does not teach or even suggest a system and method for dynamically adding computer software features to a software application.

As described at length in Applicant's previously filed response, Mehta et al. merely teaches a Mobile Application System (MAS) and related method of downloading content or complete applications for use on a mobile device. The content or complete application can be filtered for prohibited content, malicious code, whether or not an application is supported by the mobile device, etc. (*See, e.g.*, Abstract, line 28, page 12, line 26-page 14, line 24, page 19, line 16-page 21, line 24, page 49, line 19-page 50, line 6). The nature of Mehta et al. is demonstrated at, for example, page 9, lines 21-25:

The MAS is a collection of interoperating server components that work individually and together in a secure fashion to provide applications, resources, and other content to mobile subscriber devices. The MAS allows, for example, wireless devices, such as cellular phones and handset devices, to dynamically download new and updated applications from the MAS for use on their devices. (emphasis added)

Page 10, lines 13-21 of Mehta et al. further states that:

One skilled in the art will recognize that other embodiments of the methods and systems of the present invention may be used for many other purposes, including maintaining and distributing software and other content over non-wireless networks, such as the Internet, to non-wireless subscriber devices, such as a personal computer, a docked wireless handset, telephones with Internet connectivity, or customer kiosks, for example, within airports or shopping malls. In addition, although this description primarily refers to content in the form of applications and resources, one skilled in the art will recognize that the content may contain text, graphics, audio, and video. (emphasis added)

Therefore, it is clear that Mehta teaches handling, as described above, complete applications and downloadable media content for use with applications on a mobile device, e.g., a ring tone or graphical icon. In no way whatsoever does Mehta et al. ever contemplate, let alone disclose the ability to add features to an application. At best, the new applications and/or content of Mehta et al. could be interpreted, for the sake of argument, to be analogous to the consumer application. However, as described above, it is a feature that is utilized with/at the consumer application, where the feature is added in accordance with a consumer interest and provided by a provider.

The Examiner correctly recognized that Mehta et al. does not contemplate establishing a framework for an application programming interface (API), nor does Mehta et al. teach providing an interface for a consumer application and provider application such that a feature interest is matched with one of the features available from the provider application. However, the Examiner asserted that Rothman et al. cures these deficiencies of Mehta et al. Applicant disagrees. In particular, Applicant submits that Rothman et al. is directed solely to firmware and that no mention is ever made in Rothman et al. regarding the provision of interfaces and matching features available from a provider application.

Rothman et al. teaches a system and method of updating firmware in an operating system (OS) via the use of an OS-agnostic API. (*See, e.g.,* Abstract and paragraph [0016]). “Firmware” is understood by those of ordinary skill in the art to refer to, for example, software that is stored in some non-volatile memory for controlling the hardware of a device, e.g., booting a computer system, controlling the speakers of a personal computer, etc. “Applications,” such as those described in the claims of the present application refer, for example, to executable programs that operate on the OS. That is, applications can be calendar software, email software, etc., where these applications do not control hardware. In other words, although all firmware may be software, not all software is firmware. Rothman et al. makes this distinction clear as the term “application” is never used therein and where the firmware is described as being that software which is stored on a motherboard device or add-in, card firmware associated with ROMs. (*See, e.g.,* paragraph [0035]). Therefore, Applicant submits that it would not have been obvious for one of ordinary skill in the art to have combined Mehta et al. with Rothman et al. in that each is directed to solving a completely

different problem. In other words, there is no reasonable motivation why a system conceived for the purpose of updating complete applications on a mobile device should be modified by a system conceived for updating firmware on a computer system. Moreover, even if, for arguments sake, Mehta et al. and Rothman et al. could be combined, the resulting system and method would merely provide a way to update complete applications and a way to update firmware using an OS-agnostic API framework. In contrast, claims 1, 8, 17, and 21 require requesting from an application interworking framework, a feature matching a consumer interest of a consumer application and providing the feature to the consumer application.

In addition, Rothman et al., as described above, teaches updating firmware yet does not ever mention or contemplate specific firmware features which are matched with a consumer interest, as required by independent claims 1, 8, 17, and 21. In fact, no mention is made at all of “consumers,” “consumer interests,” or “consumer applications” in Rothman et al. with regard to firmware. Therefore, again, even if for arguments sake, Mehta et al. and Rothman et al. were combined, only complete applications and/or firmware could be updated and the only consumer-related interaction would involve the complete applications of Mehta et al.

It should also be noted that at page 2, section 5 of the outstanding Official Action, the Examiner indicated that Applicant’s arguments were moot in light of the new rejection. Applicant submits that the new rejection, i.e., the inclusion of Rothman et al. was done, because in the Examiner’s opinion, Rothman et al. teaches a framework API. However, Applicant’s arguments to Mehta et al. were also directed to the fact that Mehta et al. only contemplates the updating or downloading of complete content and/or applications. Section 707.07(f) of the MPEP states that “[W]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and *answer the substance of it.*” (emphasis added). In this instance, although the Examiner maintained his use of Mehta et al. in the above rejection, he failed to substantially answer, rebut, or further provide evidence to support his position that Mehta et al. reads on the claims of the present application with regard to providing features for use in a consumer application. Therefore, Applicant respectfully submits that the outstanding Official Action is improper in

that it is unresponsive to Applicant's arguments and in violation of Section 707(f) of the MPEP.

Because none of the references cited by the Examiner, either separately or in combination with each other, teach all of the required limitations of independent claims 1, 8, 17, and 21, Applicant submits that each these independent claims are patentable over this prior art. Furthermore, because dependent claims 2-7, 9-16, 18-20, 22, and 23 are each directly or indirectly dependent upon independent claims 1, 8, 17, and 21, Applicant submits that each of these claims are allowable for at least the same reasons as discussed above.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-0872.

Respectfully submitted,

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